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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218001
Party	Defendant Mycoskie, LLC
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Signature	/Louis S. Ederer/
Date	02/22/2016
Attachments	2016-02-22 - Mycoskie Reply MTC.pdf(181861 bytes) 2016-02-22 - L. Ederer Reply Declaration & Exhibits.pdf(516163 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Matter of Application Serial No. 86/004,044
Published in the *Official Gazette* on April 29, 2014
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For the Mark: TOMS

TOD'S S.P.A., Opposer/Petitioner, -against- MYCOSKIE, LLC, Applicant/Respondent.	**Opposition No.: 91218001 (parent)** Cancellation No.: 92061234

APPLICANT/RESPONDENT MYCOSKIE, LLC'S REPLY MEMORANDUM IN FURTHER SUPPORT OF APPLICANT/RESPONDENT'S CROSS-MOTION TO COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI

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Preliminary Statement

If there is any *inter partes* proceeding in TTAB history where a person purporting to reside in a foreign country should be compelled to appear for oral deposition in the U.S., this is the one. Putting aside the fact that two Tod's witnesses testified that Stefano Sincini regularly conducts business in the U.S. as the highest ranking official of Tod's U.S. subsidiary — testimony Sincini now disputes — how is it possible that the head of a U.S. company that lists his address in public filings as "450 West 15th Street New York, NY 10011" can avoid being deposed here by saying: "Sorry, I know I'm in charge of that company in New York, but I run it only from abroad"? If the purpose of TBMP § 404.03(b) is to protect foreign residents who otherwise have no connection to the U.S. from the expense of appearing here for deposition, Sincini should not be entitled to such protection.

Tod's counsel's gamesmanship throughout these proceedings provides an additional basis for stripping Sincini of such protection. Tod's counsel knew for a year-and-a-half that Sincini was the only Tod's witness capable of addressing the crucial issues of why Tod's waited eight years before first deciding in August 2014 to challenge any TOMS trademark filing, and why Tod's allowed three TOMS registrations to go incontestable before taking any action. Yet, for that same eighteen month period, deliberately ignoring his client's obligations under the Federal Rules, Tod's counsel refrained from identifying Sincini in Tod's initial disclosures, in the hope that Mycoskie would not seek to depose him. And, although counsel continues to take the position that Tod's was not required to identify Sincini as a witness possessing discoverable facts, and that Tod's only amended its initial disclosures to "err on the side of caution," the truth is it was Tod's counsel's plan all along to identify Sincini just before the close of discovery. Why? Because Tod's counsel knew, first, that it would be too late for Mycoskie to depose him, and second, that if it did not identify Sincini, Tod's would risk the distinct possibility that Sincini would be excluded from testifying at trial. Tod's should not be rewarded for such gamesmanship.

Finally, to the extent the Board does not order Sincini to appear for immediate oral deposition in the U.S., it should either order him to appear for deposition the next time he travels to the U.S., or allow Mycoskie to take his deposition in Italy. In response to the latter request for relief, which is, in essence, a

separate application under TBMP § 520, Tod's argues that Mycoskie should not be entitled to such relief because (i) it failed to meet and confer on this issue (which is not only wrong, but not required), and (ii) were Sincini to be so compelled, so could any other foreign resident. That, however, is not the law. Instead, Board precedent is clear that where, as here, a foreign witness is in unique possession of evidence going to a critical issue in the case, that witness should be directed to appear for oral deposition in his home country.

The bottom line is the Board should take appropriate action and order Sincini to appear for oral deposition either in New York or Italy.

I. The Board Should Grant Mycoskie's Motion to Compel the Sincini's Oral Deposition in New York

a. Mycoskie's Counsel Made Good Faith Efforts to Resolve The Issues Raised in Mycoskie's Motion to Compel

Tod's first contends that Mycoskie's cross-motion should be denied because Mycoskie failed to engage in a proper pre-motion meet and confer. In particular, Tod's claims that Mycoskie failed to "lay all its cards on the table" because it did not present the two alternative options it now makes part of its cross-motion: to depose Sincini (i) in New York upon his next visit here, or (ii) in Italy, either in-person or by way of video conference, with Mycoskie to pay Tod's counsel's reasonable travel and accommodation expenses. Tod's could not be more wrong.

First, Tod's glosses over the course of events that led to the filing of Mycoskie's cross-motion, and ignores the fact that it was *Tod's* counsel who unilaterally cut short the parties' pre-motion discussions. As the correspondence between counsel reveals, what led to the filing of both motions was Tod's counsel's long-planned gambit, three days before the close of discovery, to both (i) seek to amend Tod's pleadings to add a new claim for lack of bona fide intent to use the TOMS mark, and (as a complete afterthought, or so Tod's made it seem)[1] to withdraw its year-and-a-half old claim for dilution, and (ii) to

[1] As indicated in Mycoskie's cross-motion (Mycoskie Opp. at 12), it was not until after Tod's filed its rebuttal expert disclosure that Mycoskie learned the true reason for Tod's proposed amendment — the withdrawal of its dilution claim and accompanying allegation of fame — for no reason other than to provide justification for attacking

Footnote continued on next page

supplement its eighteen month-old initial disclosures to identify Sincini as a witness with discoverable information about Mycoskie's Delay Defenses.[2] Taken aback by Tod's eleventh-hour requests, but seeking to respond in good faith, Mycoskie offered to consent to Tod's proposed amendments (not realizing their true purpose) if Tod's would agree to produce Sincini, Chairman of the Board of Deva, Inc., Tod's U.S. subsidiary, for oral deposition in New York. Within a day, Tod's counsel rejected Mycoskie's reasonable proposal — flatly refusing to produce Sincini for oral deposition under any conditions, and stating that since "[t]he circumstances are the same as they have always been," any deposition of Sincini would need to proceed on written questions (Ederer Opp. Decl. ¶ 33, Ex. 28). Two days later, without further discussion or warning, Tod's counsel filed Tod's motion to amend, and all pre-motion communications ended.

The "circumstances" Tod's counsel is referring to, as Tod's suggests in its opposition brief, were that in July and August 2015, Mycoskie's counsel, as a matter of professional courtesy, had sought Tod's counsel's agreement to conduct the oral depositions of certain Italian-based witnesses who had been identified by Tod's in its initial disclosures or designated as Tod's Rule 30(b)(6) corporate representatives (none of whom included Sincini), first in New York, and then in Italy by videoconference or telephone (Ederer Reply Decl. ¶ 3, Ex. 1).[3] Tod's counsel, however, flatly refused both requests, relying on TBMP § 404.03(b). *Id.* Having already taken this firm position six months earlier, it was not difficult for Mycoskie to figure out what Tod's counsel meant when, during the parties' pre-motion communications in December 2015, he responded to Mycoskie's good faith proposal to take Sincini's oral deposition in New York, in exchange for Mycoskie's consent to Tod's proposed amendment of its pleadings, by stating

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Footnote continued from previous page
Mycoskie's confusion survey which demonstrated zero confusion. While Tod's excuse was that it had simply decided, after a year-and-a-half, that it just didn't feel like pursuing that claim anymore, this alone did not require Tod's to retract its allegation of fame, which could still bear on the issue of likelihood of confusion. Indeed, if anyone was not forthcoming in the pre-motion meet and confer process, it was Tod's, not Mycoskie.

[2] The defined term "Delay Defenses" refers to Mycoskie's affirmative defenses of laches, waiver, acquiescence, and estoppel (*see* Mycoskie Opp. at 3).

[3] References to "Ederer Reply Decl." are to the accompanying Reply Declaration of Louis S. Ederer, dated February 22, 2016.

that "[t]he circumstances are the same as they have always been" (Ederer Opp. Decl. ¶ 33, Ex. 28). Further, given this background, the disingenuousness of Tod's position — that, *if only* during the pre-motion process Mycoskie had offered to conduct Sincini's deposition in Italy rather than New York, Tod's might have agreed and this motion would have been unnecessary — is clear, and it defies credulity for Tod's to suggest that had Mycoskie only proposed that Sincini's deposition go forward in Italy instead of New York, the "[t]he circumstances [would no longer have been] the same as they have always been."

In any event, Board precedent, including those cases cited by Tod's, illustrate that Mycoskie's pre-motion efforts to confer with Tod's counsel went far beyond what was required. *Compare Domond v. 37.37, Inc.*, 113 U.S.P.Q.2d 1264, 2015 WL 370040, at *3 (T.T.A.B. 2015) (finding respondent to have properly met and conferred where respondent explained its position that petitioner's discovery requests were overly burdensome, but was met by petitioner's "apparent refusal to even discuss or engage in a constructive dialogue" regarding those requests), *with Hot Tamale Mama . . . & More, LLC v. SF Invs., Inc.*, 110 U.S.P.Q.2d 1080, 2014 WL 1390527, at *2-3 (T.T.A.B. 2014) (finding a failure to properly meet and confer where the movant filed its motion to compel after making a unilateral demand and without waiting for a response, such that no "apparent disagreement or impasse" was reached). Here, the parties' email exchange — in which Mycoskie's attempt to accommodate Tod's last-minute maneuvering was quickly dismissed by Tod's counsel and followed immediately by Tod's motion to dismiss — clearly demonstrates that an impasse had been reached.

Indeed, if any party refused to engage in a proper meet and confer or "lay its cards on the table," it was Tod's, not Mycoskie. Given Tod's counsel's immediate dismissal of Mycoskie's position and rush to file the motion to amend, Mycoskie had no time to suggest any alternative options to depose Sincini (even if, as noted above, Tod's had not already made clear that those alternatives would be rejected, since "[t]he circumstances are the same as they have always been"). Tod's "apparent refusal to even discuss or engage in a constructive dialogue" is precisely the type of behavior the Board discourages. *Domond*, 2015 WL 370040, at *3.

Further, and in any event, unlike TBMP § 523, TBMP § 520, under which Mycoskie moves to take Sincini's deposition in Italy, does not require the parties to meet and confer in advance of such a motion; indeed, the notes to TBMP § 520 say nothing about a meet and confer.[4] So, even if it could have done so, Mycoskie's alleged failure to propose its alternative options in the meet and confer process does not violate any good faith requirements of the TBMP.

Finally, all of that said, since Tod's counsel attempts to make much out of the meet and confer issue — implying that Tod's would have readily agreed to make Sincini available for deposition either on his next visit to the U.S. or in Italy — following the receipt of Tod's opposition papers Mycoskie's counsel approached Tod's counsel and proposed to resolve Mycoskie's cross-motion by agreeing to take Sincini's deposition in Italy, with Mycoskie to bear Tod's counsel's travel and accommodation expenses. Revealingly, Tod's counsel flatly refused, stating that "[a]t this point, given that our client has already incurred the cost and burden of responding to the cross-motion and setting out its legal positions, they have determined to let the Board decide the relevant issues" (Ederer Reply Decl. ¶ 4, Ex. 2). Therefore, even if Mycoskie had been required to raise these alternative proposals in the pre-motion process, it is clear Tod's counsel would have refused them, especially in light of his August 2015 refusal to produce any witnesses for oral deposition in Italy (Ederer Reply Decl. ¶ 3, Ex. 1), and his pre-motion statement, when asked in December 2015 if Tod's would produce Sincini for deposition in New York, that "[t]he circumstances are the same as they have always been" (Ederer Opp. Decl. ¶ 33, Ex. 28).

b. The Board Should Order Sincini's Immediate Oral Deposition in New York

As for the merits of Mycoskie's motion to compel Sincini to appear for immediate oral deposition in New York, Tod's argument is two-fold. First, Tod's argues that it did not act in bad faith by waiting a year-and-a-half, and until three days before the close of discovery, to supplement its initial disclosures ("out of an abundance of caution") to identify Sincini as a witness that Tod's may rely on to respond to

[4] *See Conan Doyle Estate, Ltd. v. Sherlock Holmes Memorabilia Co.*, Opp. No. 91192738, 2011 WL 13054908, at *6-8 (Sept. 8, 2011) (finding good cause to order oral deposition of foreign witness without regard to respondent's argument that petitioner had failed to meet and confer).

Mycoskie's Delay Defenses. Second, Tod's argues that Mycoskie is not entitled to take the deposition of Sincini, the longstanding Chairman of Deva, Tod's U.S. subsidiary — the same subsidiary whose Director of Retail Operations, Stephanie Rothfeld, is one of Tod's key witnesses in this case — because he is an Italian resident who runs Tod's U.S. subsidiary from abroad. Tod's is wrong on both counts.

First, Tod's offers no plausible explanation for its failure to timely identify Sincini as the sole Tod's witness to provide trial testimony regarding Tod's eight-year delay in opposing any TOMS word mark applications. In particular, Tod's argues that it was not required to identify Sincini in its initial disclosures in order to present his testimony at trial, since trial witnesses are identified in pretrial submissions, not initial disclosures. The truth, however, is that Tod's purposefully waited — and not just "out of an abundance of caution" — until just before the close of discovery to identify Sincini in its initial disclosures in the hope that Mycoskie would believe that he would not be called as a trial witness, while at the same time protecting against the distinct possibility that he would be precluded from testifying at trial if not so identified. Waiting until three days prior to the close of fact discovery to identify Sincini was the functional equivalent of not identifying him at all.

While Tod's claims there are no cases that support the proposition that a party's failure to timely identify a key witness in its initial disclosures may be grounds to exclude that witness from testifying at trial, the case cited by Mycoskie in its opening brief, *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 U.S.P.Q.2d 1443, 2009 WL 1940147 (T.T.A.B. 2009), says just that. In *Jules Jurgensen/Rhapsody*, the Board held that the petitioner's failure to identify a "critical" witness in its initial disclosures "deprived respondent of the opportunity to seek discovery of [the witness]" and therefore the witness' proposed testimony must be excluded at trial." *Id.* at *3. Tod's attempt to distinguish that case on the grounds that the witness was not subsequently identified in the petitioner's pretrial disclosures misses the mark. As the Board specifically stated in *Jules Jurgensen/Rhapsody*, it was the petitioner's failure to name the witness in its *initial* disclosures which deprived the respondent of the opportunity to conduct proper discovery, and led to his ultimate exclusion. *Id.*

Further, numerous cases under Federal Rule 26 hold that parties who wait until just before the close of discovery to amend their initial disclosures to identify key witnesses should be precluded from offering the testimony of such witnesses at trial. *See, e.g.*, *Ebersole v. Kline-Perry*, No. 1:12CV26, 2012 WL 2673150, at *4 (E.D. Va. Jul. 5, 2012) (precluding witness from testifying at trial where defendant supplemented its initial disclosures to identify the witness one day before the close of discovery, on the grounds that the plaintiff had "clearly lacked the opportunity to depose her").[5] Similarly, and since Tod's has provided no good reason for its delay in identifying Sincini — knowing all along that he was the sole Tod's witness who could provide first-hand testimony as to reasons why Tod's waited eight years to commence these proceedings (*see* Ederer Opp. Decl. ¶ 8, Ex. 3) — Sincini should either be compelled to appear for oral deposition in New York, or be excluded from testifying at trial.

Tod's further argues that notwithstanding its bad faith conduct, should the Board determine that Mycoskie is entitled to take Sincini's deposition, under TTAB rules that deposition must proceed on written questions, since Sincini is a foreign resident. Regardless of where Sincini resides, however, the evidence is unrefuted that he is the longstanding Chairman of Tod's U.S. subsidiary, so this is not a situation where an individual residing in a foreign country who has no contacts with the U.S. is being compelled to appear in the U.S. for a deposition. While TBMP § 404.03(b) may have been intended to protect against such a situation for reasons of economic burden, it was not intended to allow the head of a U.S. business to hide behind the rule just because he happens to run the business from another country.

Further, if there was any doubt that Sincini is regularly employed (and therefore, for all intents and purposes, present) in this country, Tod's U.S. subsidiary has repeatedly represented to various U.S. governmental authorities in numerous public filings that Sincini maintains an address in the U.S. where

[5] The court's decision in *Browning v. GVA Serv. Grp.*, No. 12-cv-2258, 2014 WL 65798 (C.D. Ill. Jan. 8, 2014) is also instructive. There, the plaintiff made supplemental disclosures identifying previously undisclosed witnesses on December 20 and 24, 2013, only weeks in advance of the January 6, 2014 discovery cutoff. In support of its exclusion motion, the defendant argued, just as Mycoskie does here, that the plaintiff's "supplemental disclosures were made on the eve of the close of discovery and just prior to two major holidays, thus making it impossible for Defendant to schedule depositions of the witnesses prior to the close of discovery." *Id.* at *2. In its decision, the court indicated that, absent "extremely good reasons for the late disclosure," the belatedly disclosed witnesses should be excluded. *Id.* at *3.

he can be regularly contacted. Indeed, in one public filing after another in the State of Florida, Deva, Tod's U.S. subsidiary, has listed its directors and officers as follows:

> Stefano Sincini, Chairman, 450 West 15th Street, New York, NY 10011
> Claudio Castiglioni, Vice Chairman, 450 West 15th Street, New York, NY 10011
> Marco Giacometti, President, 450 West 15th Street, New York, NY 10011
> Richard Spata, Treasurer/Chief Financial Officer, 10 Bernard Drive, Howell, NJ 07731
> Roberto Lorenzini, CEO, c/o Deva, Inc., 450 West 15th Street, New York, NY 10011[6]

(Ederer Opp. Decl. ¶ 41, Ex. 36). Despite these repeated undertakings in public filings, Tod's would now have the Board believe that Sincini's address was fictitious, since he has no presence there. However, whether or not Sincini is physically present in New York, Tod's should nevertheless be held to the representations Deva has made time and again, in one public filing after another, that he maintains a place of business (if not a residence) in the U.S. at 450 West 15th Street, New York, NY 10011.[7] This conclusion is further supported by case law interpreting the analogous provisions of Federal Rule of Civil Procedure 45.[8] Either way, Deva's numerous corporate filings leave no doubt that Sincini maintains a regular place of business in the U.S., so there can be no legitimate dispute that he is subject to an oral deposition here.

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[6] Not all of these addresses are the business address of Deva's headquarters in New York. At least one of Deva's officers is listed at his home address in New Jersey. Additionally, in the case of Mr. Lorenzini, the company listed his address as "c/o Deva" — indicating he did not have a regular presence there — a qualification it did not feel the need to make with respect to Sincini. To the contrary, Sincini's listing indicates that he is regularly present, and therefore may be contacted, at Deva's place of business at 450 West 15th Street, New York, NY 10011.

[7] *See Lundquist v. Precision Valley Aviation, Inc.*, 946 F.2d 8, 12 (1st Cir. 1991) (finding party's "representation of New Hampshire residence on corporate reports to the New Hampshire Secretary of State" to be a "weighty" consideration supporting a finding of domicile in New Hampshire); *JBHM Educ. Grp., LLC v. Bailey*, No. CIVA108CV89SAJAD, 2009 WL 1298283, at *7 (N.D. Miss. May 8, 2009) (stating that an individual's "represent[ation] to the state of Mississippi, in corporate filings, that he is a resident of Mississippi" amounts to "persuasive evidence in favor of finding domicile in Mississippi").

[8] For example, in *RIMSTAT, Ltd. v. Hilliard*, 207 B.R. 964 (D.D.C. 1997), the defendant moved to quash a subpoena he claimed required him to travel over 100 miles from the place he resided or regularly conducted business, in violation of Federal Rule of Civil Procedure 45(c). *Id.* at 969. The plaintiff opposed the motion on the grounds that the defendant maintained a business office in the District of Columbia, where the subpoena required his appearance. *Id.* The court held that if this were true, "it would prove he regularly conducted business in the District for the purposes of Rule 45, and thus be subject to a properly issued subpoena here in D.C." *Id. See also Marine Polymer Techs. v. HemCon, Inc.*, No. 06-cv-100-JD, 2010 WL 1417646, at *1-2 (D.N.H. Apr. 5, 2010) (finding witness to be subject to deposition within 100 miles from that individual's office under Fed. R. Civ. P. 45 notwithstanding conflicting evidence as to whether that witness was an officer of the party).

II. The Board Should Grant Mycoskie's Motion to Take Sincini's Deposition In Italy

In the alternative, and as a separate application for relief, Mycoskie has cross-moved under TBMP § 520 to take Sincini 's oral deposition in Italy. As demonstrated above, Sincini is the only witness Tod's has identified as having first-hand knowledge of the reasons why Tod's waited eight years — allowing TOMS word mark registrations to go uncontested for all that time (and three to go incontestable) — before taking any action to prevent Mycoskie from maintaining such registrations. Next to the related issue of likelihood of confusion, this is the most critical issue in this proceeding. Yet, Tod's would have the Board believe that Sincini and his testimony are relatively unimportant, and a deposition on written questions is sufficient.

As Mycoskie indicated in its opening brief, *Orion Grp., Inc. v. Orion Ins. Co.*, No. 79009, 12 U.S.P.Q.2d 1923, 1989 WL 274396 (T.T.A.B. June 29, 1989) sets the standard for a finding of good cause to take an oral deposition in a foreign country. Tod's only response is to argue that *Orion Grp.* does not apply, because there the opposer was relying on the testimony of the witness in question in seeking summary judgment. But that is not the test; rather, as stated in *Orion Grp.*, the test is whether the facts to which the witness in question will testify are "central" to the proceeding, and, as here, are totally within that witness's or party's control. *Id.* at *3. If there was any doubt about this, the Board reiterated this standard in *Mary Queen of the Third Millenium, Inc. v. Found. for a Christian Civilization, Inc.*, Opp. No. 91157073, 2009 WL 1017283 (T.T.A.B. Mar. 25, 2009). In *Mary Queen*, the Board similarly found good cause for an oral deposition in a foreign country based on the centrality of the issues to which the witness would testify, and the fact that this evidence was uniquely within his knowledge:

> The Board ruled that 'facts and information central to this case . . . are solely within the control of Opposer . . . . Thus . . . an oral deposition is necessary and applicant should not be deprived of the opportunity to depose Opposer in person'.

Id. at *1.

That is exactly the case here. Not only has Tod's admitted that Sincini is the only Tod's witness with first-hand knowledge of facts relating to the central issue of Tod's delay in pursuing the relief it now

seeks, but as Tod's itself concedes in its opposition brief (Tod's Opp. at 12), that information is uniquely within Sincini's knowledge and control, since he is the key decision maker on all trademark-related and infringement issues. Thus, at a minimum, Tod's should be directed to forthwith produce Sincini for oral deposition in Italy (with Mycoskie to reimburse Tod's counsel's reasonable travel and accommodation expenses), as otherwise Tod's bad faith conduct will lead to exactly the result it was designed to achieve — to shield Sincini from oral deposition while preserving Tod's ability to put him up as a witness at trial.

Conclusion

For all the foregoing reasons, Mycoskie respectfully requests that the Board grant Mycoskie's cross-motion to compel the oral deposition of Sincini in New York, or in the alternative, to take the oral deposition of Sincini in Italy.

Dated: February 22, 2016

ARNOLD & PORTER LLP

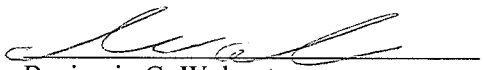
By: Louis S. Ederer

Louis S. Ederer
Matthew T. Salzmann
Benjamin C. Wolverton
Attorneys for Applicant/Respondent Mycoskie, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing **APPLICANT/RESPONDENT MYCOSKIE, LLC'S REPLY MEMORANDUM IN FURTHER SUPPORT OF APPLICANT/RESPONDENT'S CROSS-MOTION TO COMPEL THE ORAL DEPOSITION OF STEFANO SINCINI** was served upon the following attorneys of record for Opposer/Petitioner Tod's S.p.A. by U.S. Mail, this 22nd day of February, 2016:

Richard S. Mandel, Esq.
Bridget A. Crawford, Esq.
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
Attorneys for Opposer/Petitioner Tod's S.p.A.



Benjamin C. Wolverton

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Matter of Application Serial No. 86/004,044
Published in the *Official Gazette* on April 29, 2014
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In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For the Mark: TOMS

TOD'S S.P.A., Opposer/Petitioner, -against- MYCOSKIE, LLC, Applicant/Respondent	**Opposition No.: 91218001 (parent)** Cancellation No.: 92061234

REPLY DECLARATION OF LOUIS S. EDERER

I, Louis S. Ederer, pursuant to 28 U.S.C. § 1746 and Rule 2.20 of the Trademark Rules of Practice, declare as follows:

1. I am a member of the firm of Arnold & Porter LLP, attorneys for Applicant/Respondent Mycoskie, LLC ("Mycoskie") in the above entitled proceedings. I respectfully submit this declaration in reply to Opposer/Petitioner Tod's S.p.A. ("Tod's") opposition to Mycoskie's Cross-Motion to Compel the Oral Deposition of Stefano Sincini, and in further support of such cross-motion.

2. The facts contained in this declaration are within my own first-hand knowledge, and I believe them to be true.

3. Attached hereto as Exhibit 1 is a true and correct copy of an email exchange between Tod's counsel, Richard S. Mandel, Esq., and myself, commencing on July 23, 2015, and

concluding on August 31, 2015, regarding the proposed oral depositions of Tod's witnesses in New York and in Italy.

4. Attached hereto as Exhibit 2 is a true and correct copy of an email exchange between Richard S. Mandel, Esq. and myself, commencing on February 2, 2016 and concluding on February 8, 2016, regarding the proposed oral deposition of Mr. Sincini in Italy.

I hereby declare under penalty of perjury that the foregoing is true and correct. Executed in New York, New York on the 22nd day of February, 2016:

Louis S. Ederer

EXHIBIT 1

From: Mandel, Richard <RSM@cll.com>
Sent: Monday, August 31, 2015 11:26 AM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Lou,

I have confirmed that we can make Stephanie Rothfeld available for a deposition on October 8 and Claudio Castiglioni available on October 9. Please confirm that those dates would work for you.

With respect to the 30(b)(6) issue, Mr. Castiglioni can testify as the corporate representative with respect to topics 1, 4-6 and 8-18 from your notice. The witness for the remaining topics would need to be an individual in Italy. Let us know if that is sufficient for your purposes.

Finally, we are not prepared to make Ms. Pinotti available for a deposition other than through the procedure of depositions upon written questions.

Richard S. Mandel, Esq.
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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Wednesday, August 12, 2015 10:01 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

As a follow-up, we confirm that we are prepared to take the depositions of the two Tod's witnesses the week of October 5. Please provide suggested dates, and also let us know where things stand on the other points we discussed recently by phone.

Regards,

Louis S. Ederer
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From: Ederer, Louis S.
Sent: Thursday, August 06, 2015 5:10 PM
To: 'Mandel, Richard'
Cc: 'Emert, Aryn M.'; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

Thank you for taking the time to speak with me today. I am writing to confirm the following discussion points.

First, while we do not concede that Tod's S.p.A. ("Tod's") cannot be noticed for a 30(b)(6) deposition, or that its corporate representative witnesses need not be produced for oral deposition in the US, as a starting point we have asked whether you can advise us if there are any potential witnesses residing in the US, including, for example, Mr. Castiglioni and Ms. Rothfeld, who can be designated for certain of the topics in the notice, particularly those which concern Tod's US activities, and then we can determine how to deal with any 30(b)(6) topics for which you might be inclined to designate an Italian resident. We appreciate your willingness to look into this further.

Further, we renew our request that Tod's make available Sylvia Pinotti for oral deposition, which we are willing to conduct remotely via telephone or video conference. Although we understand that Tod's has yet to determine whether Ms. Pinotti will actually testify as a witness in this proceeding, to the extent she will, we believe we should have an opportunity to depose her, particularly since Ms. Pinotti appears to the only individual listed by Tod's as being knowledgeable about claims of actual consumer confusion. In any case, and as a matter of courtesy, we ask you to consider this request, and appreciate your willingness to at least address this issue with your client.

Finally, we preliminarily confirm that we are available to conduct depositions of Mr. Castiglioni and Ms. Rothfeld on consecutive days during the week of October 5 (not including October 5 itself, as you requested), subject to confirmation from both Ms. Rothfeld and our client as to their availability. We will contact you when we receive such confirmation.

Please do not hesitate to contact me if you would like to discuss any of the foregoing.

Regards,

Louis S. Ederer
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From: Ederer, Louis S.
Sent: Wednesday, August 05, 2015 5:34 PM
To: 'Mandel, Richard'
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard:

I will call you tomorrow.

Regards,

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From: Mandel, Richard [mailto:RSM@cll.com]
Sent: Wednesday, August 05, 2015 12:05 PM
To: Ederer, Louis S.
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Hi, Lou. Did you finish your trial? Wanted to check in to talk about how to proceed regarding depositions when you have a chance.

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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Sunday, July 26, 2015 12:44 PM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Richard, that should be OK. The rest will have to wait.

Thanks,

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From: Mandel, Richard [mailto:RSM@cll.com]
Sent: Sunday, July 26, 2015 11:00 AM
To: Ederer, Louis S.

Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: RE: Tod's v. Toms

Thanks, Lou. If it's possible to have someone get back to me at least on the extension for discovery responses, I would appreciate it since we're closing in on that deadline. But if it has to wait also until after your trial, then we can discuss then.

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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Sunday, July 26, 2015 6:31 AM
To: Mandel, Richard
Cc: Emert, Aryn M.; Salzmann, Matthew T.; Wolverton, Benjamin
Subject: Re: Tod's v. Toms

Richard:

I am on trial this week. I will get back to you next week.

Thanks,

Louis S. Ederer
Arnold & Porter LLP
louis.ederer@aporter.com

From: Mandel, Richard [mailto:RSM@cll.com]
Sent: Thursday, July 23, 2015 11:46 AM Eastern Standard Time
To: Ederer, Louis S.
Cc: Emert, Aryn M. <AME@cll.com>
Subject: Tod's v. Toms

Lou,

I am writing to you with respect to your recently served discovery requests and deposition notices. With respect to the discovery requests, we are going to need some additional time to respond. Because Tod's is effectively closed down for several weeks during August, we would ask that you extend our time until September 11 (a little over 30 days) to respond to the interrogatories and document requests. Let us know if that is acceptable.

With respect to depositions, Ms. Rothfeld is available on the September 17 date you have noticed and we can proceed at that time. However, if you would rather reschedule to a later date based on our requested

extension of time to answer your discovery requests, we would of course be willing to do so. Let us know your preference in this respect and if necessary, we can look for alternative available dates.

Although Mr. Castiglioni does not reside in New York, he has a dual US residency in Florida (along with his Italian residence), and accordingly we are prepared to produce him in the U.S. for a deposition. For everyone's convenience, we will make him available in New York. He would be available for a deposition the week of October 5. Let us know if there are any dates that week that would be convenient for you. My preference would be to avoid the Monday, Oct. 5 if possible.

Finally, with respect to Ms. Pinotti and the 30(b)(6) deposition of Tod's, we do not believe that it is proper under the rules to notice them for oral depositions in New York. Rather, because Ms. Pinotti and Tod's reside in Italy, any such depositions should be taken by written questions. See TBMP 404.03(b). Please advise whether you wish to proceed in such fashion, or whether the depositions of Ms. Rothfeld and Mr. Castiglioni will be sufficient for your purposes.

If you wish to discuss any of these issues further, please feel free to call me.

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EXHIBIT 2

From: Mandel, Richard <RSM@cll.com>
Sent: Monday, February 08, 2016 5:11 PM
To: Ederer, Louis S.
Cc: Crawford, Bridget A.; Wolverton, Benjamin; Salzmann, Matthew T.
Subject: RE: Tod's/Toms

Lou,

Thank you for your email. At this point, given that our client has already incurred the cost and burden of responding to the cross-motion and setting out its legal positions, they have determined to let the Board decide the relevant issues.

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From: Ederer, Louis S. [mailto:Louis.Ederer@APORTER.COM]
Sent: Thursday, February 04, 2016 7:07 PM
To: Mandel, Richard
Cc: Crawford, Bridget A.; Wolverton, Benjamin; Salzmann, Matthew T.
Subject: RE: Tod's/Toms

Richard:

We have reviewed the papers you served and filed on Tuesday in the above matter. We write in particular about an issue you have raised in your opposition to Mycoskie's cross-motion.

In your opposition, you argue, among other things, that Mycoskie's cross-motion should be denied because our office did not engage in a proper pre-motion meet and confer. In particular, you refer to that portion of our cross-motion where we seek the alternative relief of either an order compelling Mr. Sincini to be orally deposed in the US on his next visit here, or in Italy (either in person or by videoconference). You then go on to argue that neither of those options was presented to Tod's before Mycoskie filed its cross-motion, and accordingly Mycoskie failed to make a good faith effort to resolve the issues raised by its cross-motion.

While Mycoskie rejects out of hand your position that it did not engage in a proper meet and confer, and reserves all arguments with respect to that position as well as its cross-motion, I write to advise you that Mycoskie is willing to resolve its cross-motion if you were to agree to produce Mr. Sincini for oral deposition in Italy, with Mycoskie to reimburse you for your reasonable travel and accommodation expenses. We would also be willing to resolve the cross-motion by agreeing to take Mr. Sincini's oral deposition in New York upon his next visit here, but you have indicated in your opposition papers that he has no plans to travel to the US in 2016.

Please respond by the close of business Monday, February 8, 2016.

Yours truly,

Louis S. Ederer
Partner
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From: Mandel, Richard [mailto:RSM@cll.com]
Sent: Tuesday, February 02, 2016 1:51 PM
To: Ederer, Louis S.; Wolverton, Benjamin; Salzmann, Matthew T.
Cc: Crawford, Bridget A.
Subject: Tod's/Toms

Attached are courtesy copies of the reply papers in support of Tod's' motion to amend and the opposition papers to Mycoskie's cross-motion which have been served and filed today.

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